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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,485	11/27/2001	Alexey G. Ryazanov	601-1-078DIV	1500

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EXAMINER

ANDRES, JANET L

ART UNIT PAPER NUMBER

1646

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action****Application No.**

09/994,485

**Applicant(s)**

RYAZANOV ET AL.

**Examiner**

Janet L. Andres

**Art Unit**

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 17 February 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 51-59.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*[Signature]*  
PATENT EXAMINER

Continuation of 2. NOTE: The claims now require that the antibody not react with non-human, non-mouse, or non-C elegans kinases. There is no support in the specification for this negative limitation..

Continuation of 3. Applicant's reply has overcome the following rejection(s): The declaration by Ryanazov is sufficient to overcome the rejections under 35 U.S.C. 102(a) based on Ryanazov et al., PNAS 1997. Applicant's amendment is also sufficient to overcome the rejection of claim 58 under 35 U.S.C. 112, second paragraph, as indefinite in the recitation of "active fragment".

The amendment requiring that the claimed antibodies not react with sequences from other species would be sufficient to overcome the rejections under 102(b) and 103(a) as anticipated by or obvious over Redpath; however, the amendment introduces new matter and will not be entered.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments with respect to the rejection of claim 59 under 35 U.S.C. 112, first paragraph, as lacking enablement, have been fully considered but have not been found to be persuasive. As stated in the previous office action, the claim requires that there be a pharmaceutical use for the antibody. Applicant has provided no guidance as to how the artisan would use such an antibody in a pharmaceutically effective way. As stated in the office action of 28 January 2003, there is no guidance as to what cancers the antibodies could detect, and what the significance of that detection would be. Applicant's arguments with respect to the rejection of claims 51-59 under 35 U.S.C. 112, second paragraph, as indefinite in the recitation of "specifically binds" have been fully considered but have not been found to be persuasive. Applicant argues that "specifically binding" is recognized by the artisan to mean specific binding to an epitope. This argument does not serve to define what is intended by "specific".